

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. : **10/087797**
Applicant : Herbert
Filing date : March 5, 2002
Title : Mail Preparation System
TC/A.U. : 3624
Examiner : **Charles**
Docket No. : **5126**
Customer No. : 26936

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPELLANTS' BRIEF ON APPEAL TO
THE BOARD OF PATENT APPEALS AND INTERFERENCES

Sir:

This is appellant's brief on appeal to the Board of Patent Appeals and Interferences, from the final rejection of the application identified above.

REAL PARTY IN INTEREST

The owner of this application is Neopost Limited, under an assignment recorded at reel 010336, frame 0416.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 1 - 10 and 11 - 12 have been canceled. Claims 11 and 14 - 24 stand rejected. Claims 11 and 14 - 24 are being appealed.

STATUS OF AMENDMENTS

All amendments have been entered.

SUMMARY OF THE CLAIMED SUBJECT MATTER

Claim 11 is for a method of mail preparation. The method includes steps of processing a first mail item (16, Fig. 1; page 4, line 23) comprising a mail item in a series of mail items; effecting an accounting operation in respect of a first postage charge for the first mail item, and generating (page 8, line 1) a first postage indicium (18, Fig. 1; page 8, line 24) to provide evidence that the accounting operation has been effected in respect of the first postage charge; processing a second mail item comprising a mail item, subsequent to the first mail item, in the series of mail items; determining (step 35, Fig. 5; page 9, line 23) whether the first postage charge remains unused, with the first postage charge remaining unused when processing of the first mail item has not been completed; where the first postage charge is unused, determining (step 36, Fig. 3; page 9, line 29) whether the first postage indicium is suitable for use in relation to the second mail item. If the first indicium is suitable, the method generates (step 37 in Fig. 3; page 10, line 3; also step 50 in Fig. 5; page 14, line 14) a substitute postage indicium to provide evidence in relation to the second mail item that the accounting operation has been effected in respect of the first postage charge, wherein the step of generating a substitute postage indicium includes the step of providing an indicator (39, Fig. 1; page 11, line 31) in the first postage indicium indicative that the accounting operation for the first postage charge relates to the second mail item; and where the first postage indicium is not suitable for use in relation to the second mail item, effecting (step 31; page 9, line 27) an accounting operation in respect of a second postage charge for the second mail item, and

generating (step 33; page 8, line 1) a second postage indicium to provide evidence that the accounting operation has been effected in respect of the second postage charge.

Claim 20 is for a mail preparation apparatus which includes an accounting unit operable to effect an accounting operation in respect of postage charges for mail items (16, Fig. 1; page 4, line 23) in a series of mail items, and generate postage indicia to provide evidence that accounting operations have been effected in respect of the postage charges, wherein the accounting unit is configured to effect an accounting operation in respect of a first postage charge for a first mail item in a series of mail items, and generate (page 8, line 1) a first postage indicium to provide evidence that the accounting operation has been effected in respect of the first postage charge; and in processing a second mail item comprising a mail item, subsequent to the first mail item, in the series of mail items, determine (step 35, Fig. 5; page 9, line 23) whether the first postage charge remains unused, with the first postage charge remaining unused when processing of the first mail item has not been completed, and, where the first postage charge is unused, determine (step 36, Fig. 3; page 9, line 29) whether the first postage indicium is suitable for use in relation to the second mail item, and, where the first postage indicium is suitable for use in relation to the second mail item, generate (step 37 in Fig. 3; page 10, line 3; also step 50 in Fig. 5; page 14, line 14) a substitute postage indicium to provide evidence in relation to the second mail item that an accounting operation has been effected in respect of the first postage charge, with the substitute postage indicium comprising the first postage indicium and an indicator therein indicative that the accounting operation for the first postage charge relates to the second mail item, and, where the first postage indicium is not suitable for use in relation to the second mail item, effect (step 31; page 9, line 27) an accounting operation in respect of a second postage charge for the second mail item, and generate (step 33; page 8, line 1) a second postage indicium to provide evidence that an accounting operation has been effected in respect of the second postage charge.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 11, 18 and 20 are rejected under section 112, second paragraph.

Claims 11 and 14 - 24 are rejected as anticipated by US Patent 5768132 (Cordery *et al*).

ARGUMENT

Claim Rejections – 35 USC 112

Claims 11, 18 and 20 were rejected as unclear, on the ground they fail to define expressly what renders the first postage indicium suitable for use in relation to the second mail item.

Firstly, with regard to the objection to claim 18, this rejection is not understood, since claim 18 makes no reference to determining the suitability of the first postage indicium.

As regards claims 11 and 20, it is submitted those claims clearly define the invention, insofar as they state that a check is performed to determine whether the first postage indicium is suitable for use in relation to the second mail item.

Claims 11 and 20 encompass any method or apparatus, respectively, which performs such a check, irrespective of the criteria which are being checked. This aspect of the claimed invention resides in the performance of this check, and not the specific criteria which are checked.

Furthermore, we note that Cordery *et al.* uses the same terminology (see claims 1 and 15), that is, whether a previously-generated digital token is "suitable for use" in a subsequent mail collation, without any reference to the criteria. The allowance of this

patent, using the same terminology, demonstrates that the terminology has a clear meaning to a person skilled in the art, particularly given the fact that the assignee of that patent is a market leader in such technology.

Claim Rejections – 35 USC 102

Claims 11 and 14 to 24 were finally rejected as being anticipated by Cordery *et al.* We submit that these claims are not anticipated by the reference. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Independent claims 11 and 20 each contain at least one element not disclosed in or inherent from Cordery *et al.*

Claim 11 is directed to a method of mail preparation which includes *inter alia* the steps of (the steps being referenced for ease of identification):

- (a) processing a first mail item comprising a mail item in a series of mail items;
- (b) effecting an accounting operation in respect of a first postage charge for the first mail item, and generating a first postage indicium to provide evidence that the accounting operation has been effected in respect of the first postage charge;
- (c) processing a second mail item comprising a mail item, subsequent to the first mail item, in the series of mail items;
- (d) determining whether the first postage charge remains unused, with the first postage charge remaining unused when processing of the first mail item has not been completed;
- (e) where the first postage charge is unused, determining whether the first postage indicium is suitable for use in relation to the second mail item; and
- (f) where the first postage indicium is suitable for use in relation to the second mail item, generating a substitute postage indicium to provide evidence in relation to the second mail item that the accounting operation has been effected in respect of the first

postage charge, wherein the step of generating a substitute postage indicium includes the step of providing an indicator in the first postage indicium indicative that the accounting operation for the first postage charge relates to the second mail item.

Cordery *et al* does not disclose the step of generating a substitute postage indicium where the first postage indicium is suitable for use in relation to the second mail item (step (f)).

The Examiner identified the disclosure at column 11, line 15 to column 12, line 45 in Cordery *et al* as disclosing the generation of a substitute indicium as required by the claimed invention.

We have studied the referenced part of Cordery *et al*, but can find no mention of the generation of a substitute indicium as alleged. The only disclosure in Cordery *et al* is to the re-use of an already-generated postage indicium (column 11, lines 26, 34, 37, 40, 43, 44 and 51 and column 12, lines 5, 7, 23, 24, 34 and 37). Cordery *et al* teaches expressly that indicia available for re-use are matched (column 12, lines 22 and 23), moved to a list of collations (column 12, lines 23 to 25) and printed (column 12, lines 25 and 26).

The Examiner also identified the passage at column 2, lines 22 to 28 in Cordery *et al*. as disclosing the step of providing an indicator in the first postage indicium indicative that the accounting operation for the first postage charge relates to the second mail item. This disclosure is directed to the re-use of digital tokens, and makes absolutely no reference to the generation of a substitute postage indicium which includes the step of providing an indicator in the first postage indicium in the manner, as required by claims 11 and 20.

This feature was originally the subject of claim 13 (now canceled), and was added to claim 11 in response to a previous Office Action which indicated that the subject matter of claim 13 would be allowable if re-written in independent form.

Cordery *et al* makes no disclosure whatsoever of the generation of a substitute postage indicium as required by the claim 11 (step (f)).

It is important to recognize that the presently-claimed invention is directed not to a system which provides for the re-use of an already-generated postage indicium, in the manner of Cordery *et al*, but rather to a system which provides for the generation of a substitute postage indicium in respect of a postage charge as applied in an earlier, unused postage indicium.

Thus, the method of claim 11 is clearly distinguished over the disclosures of Cordery *et al*.

Claims 14 to 19 depend from an allowable independent claim, claim 11, and thus themselves are deemed allowable.

Claim 20 is directed to a mail preparation apparatus which includes an accounting unit which is configured to (the features being referenced for ease of identification):

(a) effect an accounting operation in respect of a first postage charge for a first mail item in a series of mail items, and generate a first postage indicium to provide evidence that the accounting operation has been effected in respect of the first postage charge; and

(b) in processing a second mail item comprising a mail item, subsequent to the first mail item, in the series of mail items, determine whether the first postage charge remains unused, with the first postage charge remaining unused when processing of the first mail item has not been completed, and, where the first postage charge is unused, determine

(b1) whether the first postage indicium is suitable for use in relation to the second mail item, and,

(b2) where the first postage indicium is suitable for use in relation to the second mail item, generate a substitute postage indicium to provide evidence in relation to the second mail item that an accounting operation has been effected in respect of the first postage charge, with the substitute postage indicium comprising the first postage indicium and an indicator therein indicative that the accounting operation for the first postage charge relates to the second mail item.

For the same reasons put forward in relation to claim 11 – inasmuch as step (b2) of claim 20 corresponds to step (f) of claim 11 and requires generation of a substitute postage indicium which includes the step of providing an indicator in the first postage indicium – we submit that claim 20 clearly distinguishes the present mail preparation apparatus from the disclosures of Cordery *et al.*

With regard to claims 21 to 24, these claims are dependent upon an allowable independent claim, claim 20, and thus themselves are deemed allowable.

Respectfully submitted,

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CLAIMS APPENDIX

11. A method of mail preparation, including the steps of:

- processing a first mail item comprising a mail item in a series of mail items;
- effecting an accounting operation in respect of a first postage charge for the first mail item, and generating a first postage indicium to provide evidence that the accounting operation has been effected in respect of the first postage charge;

- processing a second mail item comprising a mail item, subsequent to the first mail item, in the series of mail items;

- determining whether the first postage charge remains unused, with the first postage charge remaining unused when processing of the first mail item has not been completed;

- where the first postage charge is unused, determining whether the first postage indicium is suitable for use in relation to the second mail item;

- where the first postage indicium is suitable for use in relation to the second mail item, generating a substitute postage indicium to provide evidence in relation to the second mail item that the accounting operation has been effected in respect of the first postage charge, wherein the step of generating a substitute postage indicium includes the step of providing an indicator in the first postage indicium indicative that the accounting operation for the first postage charge relates to the second mail item;
- and

- where the first postage indicium is not suitable for use in relation to the second mail item, effecting an accounting operation in respect of a second postage charge for the second mail item, and generating a second postage indicium to provide evidence that the accounting operation has been effected in respect of the second postage charge.

14. A method as claimed in claim 11, wherein the substitute postage indicium includes a cryptographic token and the cryptographic token is based in part upon the indicator.

15. A method as claimed in claim 11, wherein the first postage indicium is generated to include a flag in a first state, and the substitute postage indicium is generated with the flag in a second state different from the first state.

16. A method as claimed in claim 15, wherein the substitute postage indicium includes a cryptographic token and the cryptographic token is based in part upon the state of the flag.

17. A method as claimed in claim 11, wherein the step of generating the first postage indicium is based at least in part on a recipient address, and the step of determining whether the first postage indicium is suitable for use in relation to the second mail item includes the step of determining whether the recipient address of the second mail item is the same as the recipient address of the first mail item.

18. A method as claimed in claim 11, further including the steps of:

- storing the first postage indicium and a marker relating to the stored first postage indicium; and

- setting the marker where processing of the first mail item is not completed.

19. A method as claimed in claim 18, further including the step of:

- resetting the marker relating to the stored first postage indicium where the first postage indicium is determined to be suitable for use in relation to the second mail item.

20. Mail preparation apparatus, including:

- an accounting unit operable to effect an accounting operation in respect of postage charges for mail items in a series of mail items, and generate postage indicia to provide evidence that accounting operations have been effected in respect of the postage charges;

- wherein the accounting unit is configured to:

effect an accounting operation in respect of a first postage charge for a first mail item in a series of mail items, and generate a first postage indicium to provide evidence that the accounting operation has been effected in respect of the first postage charge; and

in processing a second mail item comprising a mail item, subsequent to the first mail item, in the series of mail items, determine whether the first postage charge remains unused, with the first postage charge remaining unused when processing of the first mail item has not been completed, and, where the first postage charge is unused, determine whether the first postage indicium is suitable for use in relation to the second mail item, and, where the first postage indicium is suitable for use in relation to the second mail item, generate a substitute postage indicium to provide evidence in relation to the second mail item that an accounting operation has been effected in respect of the first postage charge, with the substitute postage indicium comprising the first postage indicium and an indicator therein indicative that the accounting operation for the first postage charge relates to the second mail item, and, where the first postage indicium is not suitable for use in relation to the second mail item, effect an accounting operation in respect of a second postage charge for the second mail item, and generate a second postage indicium to provide evidence that an accounting operation has been effected in respect of the second postage charge.

21. An apparatus as claimed in claim 20, wherein the substitute postage indicium includes a cryptographic token and the cryptographic token is based in part upon the indicator.

22. An apparatus as claimed in claim 20, wherein the first postage indicium is generated to include a flag in a first state, and the substitute postage indicium is generated with the flag in a second state different from the first state.

23. An apparatus as claimed in claim 22, wherein the substitute postage indicium includes a cryptographic token and the cryptographic token is based in part upon the state of the flag.

24. An apparatus as claimed in claim 20, wherein the first postage indicium is generated based at least in part on a recipient address, and the first postage indicium is determined to be suitable for use in relation to the second mail item where the recipient address of the second mail item is the same as the recipient address of the first mail item.

EVIDENCE APPENDIX

(Not applicable.)

RELATED PROCEEDINGS APPENDIX

(Not applicable.)